

REMARKS

Status of the Application

Claims 1-9 and 11-29 have been examined in the pending application. Claims 21-23 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Claims 7-9, 21-23 and 28 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. Claims 1-29 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3, 6-8, 11-13, 15-17, 20-22, 24-25, and 27-29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McIntyre et al. (U.S. Pat. App. Pub. No. 2004/0201709). Claims 5, 14, 19 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntyre. Claims 4, 9, 18 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntyre in view of Admitted Prior Art.

By this Amendment, Applicant is amending claims 1, 2, 6, 7, 12, 13, 15, 16, 20, 21, 25, 26, 28 and 29.

Preliminary Matters

The Examiner has acknowledged Applicant's claim to foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

The Examiner has also acknowledged acceptance of the drawings filed August 27, 2003.

Oath Objection

The Examiner objects to the declaration as allegedly being defective under MPEP §§ 602.01 and 602.02 because the declaration does not indicate that the declaration applies to the “attached” application or the serial number and date of filing of the application.

Applicant respectfully submits that the declaration is not defective, and properly indicates that the declaration applied to the “attached” application. On the first page of the declaration filed August 27, 2003, the line below the title of the invention states: “the specification of which is attached hereto *unless the following box is checked:*” (emphasis added). Because the box is not checked, the declaration indicates that it applies the “attached application.” Additionally, the declaration was filed at the same time as the specification for the present invention. Both the declaration and the request for examination claim priority from the same Japanese application. These circumstances would indicate a declaration that is properly “attached” to an application.

Specification Objection

The Examiner objects to the specification it allegedly does not contain support for claims 7-9. Specifically, the specification allegedly does not contain written support for a printing system comprising an image server connected to at least one wireless communication apparatus as recited in claim 1, which itself recites a printing system and a mini-laboratory.

Applicant respectfully submits that the specification does, in fact, provide sufficient support for claims 7-9. First, pages 5-6 of the specification discuss the invention claimed in claims 7-9. Second, FIG. 3 shows a printing system (1) comprising: an image server (11A, 11B, 11C) connected to the wireless communication apparatus (combination of 13A & 18A) via a wired communication line, for storing the image data sent from the wireless communication

apparatus; and a mini-laboratory (12A) for generating printed matter based on the image data stored in the image server. See also, page 13, line 15 through page 15, line 8.

§112 Rejections

A. Claims 21-23 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement.

The Examiner alleges that there is not support within the originally filed application for a printing system that includes an image server and a wireless communication as recited in claim 15, which includes wireless communication equipment and temporary memory, wherein the wireless communication equipment is connected via a wired communication line to a printing system. The Examiner thus alleges that there appears to be a separate printing system within the claimed printing system. The Examiner further alleges that no support exists within the originally filed specification for this printing system to include an image server connected to more than one wireless communication apparatus.

Applicant has correct the informalities noted with respect to claims 15 and 21, and withdrawal of the rejection is hereby requested.

Claims 21-23 are related to claims 7-9, but are directed to the invention as non-means plus function claims. Therefore, for reasons analogous to those presented above with respect to claims 7-9 and the specification objection, claims 21-23 have sufficient support in the specification for this printing system to include an image server connected to more than one wireless communication apparatus.

B. Claims 7-9, 21-23 and 28 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement.

Applicant has corrected the noted deficiencies. Withdrawal of the rejection is hereby respectfully requested.

C. Claims 1-29 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has corrected the noted deficiencies. Withdrawal of the rejection is hereby respectfully requested.

§102(e) Rejection

A. Claims 1-3, 6-8, 11-13, 15-17, 20-22, 24-25, and 27-29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McIntyre et al. (U.S. Pat. App. Pub. No. 2004/0201709).

Amended claim 1 recites, in part, “temporary storage means for temporarily storing said image data sent from the imaging apparatus and for coordinating the difference in communication speed between wired and wireless communications ...” The Examiner argues that McIntyre teaches or suggests all of the elements of claim 1, citing FIG. 15, elements 25, 50, 23 and 70, and paragraphs [0084] and [0062]. The Examiner has cited to two separate embodiments of McIntyre in the rejection. However, two embodiments in a single reference may not be combined absent specific teaching. See *In re Kramer*, 18 USPQ2d 1415, 1416 (Fed. Cir. 1991). Applicant respectfully submits that McIntyre fails to teach or suggest a temporary storage means for temporarily storing said image data sent from the imaging apparatus.

Paragraph [0062] and element 70, which the examiner alleges teaches this aspect of claim 1, teaches a fulfillment provider which provides image goods and/or services to users and third parties. The fulfillment provider comprises a web server, a digital printer, and a fulfillment

manager and a commerce manager. However, the fulfillment provider fails to teach or suggest that a temporary storage for temporarily storing said image data sent from the imaging apparatus. The fulfillment provider of McIntyre does not receive image data sent from the imaging apparatus, it receives the data from a service provider. Additionally, the fulfillment provider disclosed in McIntyre fails to disclose that it performs coordinating the difference in communication speed between wired and wireless communications.

Further, the Examiner notes that the wherein clause in claim 1 is not given significant patentable weight under MPEP §2111.04 because it does not appear to limit the claim scope to a particular structure. Applicant has amended claim 1 to change the “wireless communication equipment” to “wireless communication means”, such that the clause does limit the claim scope of a particular structure, and is given patentable weight. Therefore, claim 1 as amended recites, in part, “wherein said wireless communication means are connected via a wired communication line to a printing system for carrying out printing processing on said image data.” McIntyre further fails to teach or suggest this feature of claim 1. The Examiner argues that element 25 in FIG. 15 corresponds to the wireless communication means of claim 1. On page 7 of the Office Action, however, when discussing the wherein clause, the Examiner cites to the fulfillment provider 70 as the element being wired to carry out printing processing of the image data. However, in FIG. 15, the fulfillment provider center 70 is only connected to a delivery vehicle 68, which is not a wired network. Thus, the Examiner fails to provide citation in McIntyre that teaches that the same wireless communication means performs wireless communication with an imaging apparatus *and* wired communication with a printing system. Because McIntyre does not

teach both wireless and wired communication within the same means, McIntyre fails to teach all of the elements of claim 1. Claim 1 is patentable over the applied art.

Claims 2-3, 6-8, and 11-13 should be patentable at least by virtue of their dependency from claim 1.

Claim 15 recites similar elements to claim 1. Therefore, for reasons analogous to those presented with regard to claim 1, claim 15 should be patentable over the applied art. Claims 16-17, 20-22, 24-25 and 27-29 should be patentable at least by virtue of their dependency from claim 15.

§103(a) Rejections

A. Claims 5, 14, 19 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntyre.

Claims 5, 14, 19 and 26 depend from claims 1 and 15, respectively. Because McIntyre fails to disclose all of the elements of claims 1 and 15, claims 5, 14, 19, and 26 should be patentable at least by virtue of their dependency from claims 1 and 15, respectively.

B. Claims 4, 9, 18 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntyre in view of Admitted Prior Art.

Claims 4, 9, 18 and 23 depend from claim 1 and 15, respectively. Because McIntyre fails to disclose all of the elements of claims 1 and 15, and because the Admitted Prior Art fails to cure the deficiencies noted in claims 1 and 15. Claims 4, 9, 18, and 23 should be patentable at least by virtue of their respective dependencies.

Examiner's Conclusion

On page 13 of the Office Action, the Examiner points to the FedEx/Kinko's web site, <http://fedex.com/us/officeprint/main/?link=4>, which the Examiner alleges to anticipate or alternatively, render obvious, the claims of the present invention.

Applicant respectfully submits that the FedEx/Kinko's website fails to teach wireless communication means for carrying out data communication via a wireless network, as well as failing to teach a temporary storage means as recited in amended claims 1 and 15. In order to transfer image data, FedEx/Kinko's requires that an onsite Sony PictureStation be used, and that the digital media format must be brought to the FedEx/Kinko's. See

<http://www.fedex.com/us/officeprint/storesvcs/photos/picstation.html?link=4>.

The website does not mention the use of a wireless communication means, nor does the website teach the temporary storage means as recited in amended claims 1 and 15. Therefore, the website fails to teach or suggest the elements of the claimed invention, and would not render the claimed invention anticipated or obvious.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 CFR §1.111
U.S. Application No. 10/648,367

Docket No. Q77076

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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